

REMARKS

Reconsideration is respectfully requested.

Status of the Claims and Request for Rejoinder

Claims 1-19 are pending. Claims 3, 5-7, and 12-19 have previously been withdrawn from consideration. Therefore, only claims 1, 2, 4, and 8-11 are currently at issue. No amendments to the claims are made in this Response.

In response to a Restriction Requirement, Applicants provisionally elected the species of Example 1-1, page 42. The Examiner determined that the elected species was not allowable over the prior art (citing JP 4178362) and limited the search to the elected species. Consequently, claims 3 and 5-7 were withdrawn as being drawn to nonelected species.

Applicants' previous amendments and arguments resulted in the withdrawal of the rejection over JP 4178362. The claims were then rejected as anticipated by the commonly-owned WO 03/095420. In response to Applicants' arguments, this rejection was also withdrawn and recast as an obviousness rejection. In view of the discussion below, it is respectfully submitted that the elected species is allowable over the prior art of record. Rejoinder of claims 3 and 5-7 and the full examination of the claims of Group I are respectfully requested

Claim Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, and 8-11 have been rejected under 35 U.S.C. § 103(a) as being obvious over WO 03/095420 ("Yura").

Yura is only available as prior art under 35 U.S.C. § 102(e) because its publication date is later than foreign priority date of the present application. Applicants respectfully submit that Yura is disqualified as prior art under 35 U.S.C. § 103(c)(1) because the present application and Yura were both owned by Bayer HealthCare AG at the time the present invention was made.

The basis for the rejection is believed to have been addressed and overcome. Withdrawal of the rejection is respectfully requested.

Double Patenting

Claims 1, 2, 4 and 8-11 have been provisionally rejected for obviousness-type double patenting over claims 1-16 of Application No. 10/575,027 and claims 1-5 and 7 of Application No. 10/537,217. Applicants note that the latter application has issued as Patent No. 7,544,716 and is now assigned to Xention Ltd.

According to the MPEP, any obviousness-type double patenting rejection should clearly state two things: “(A) The differences between the inventions defined by the conflicting claims ...; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in the claim in the patent.” MPEP § 804 II.B.1. The Office Action merely states “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are claiming structurally similar compounds and compositions”

It is respectfully submitted that this explanation fails to provide a *prima facie* basis for an obviousness determination. In the interests of compact prosecution, it is requested that the basis for the rejection be adequately described. In order to expedite the resolution of the rejection, Applicants note below some of the significant differences between the claims of the present application and those of the ‘027 Application and ‘716 Patent.

In both the ‘027 Application and ‘716 Patent, the urea moiety is bound to the tetrahydronaphthalene ring at the 1-position, whereas the urea moiety is bound at the 2-position in the present application. As previously argued, chemical properties, such as reactivity, would be expected to differ in compounds having different substitution patterns.

Also, the present claims were previously amended so that Q₃ represents CHOH. The claims of the ‘027 Application (as currently amended) specify that when the tetrahydronaphthalene ring of a bicyclic urea is substituted in the same position by –OH, the other ring system is cycloalkyl (see R¹_{II} of claim 1, ‘027 Appl.). In contrast, the other ring system in the present claims is aryl or heteroaryl (see R¹ of claim 1). Therefore, the claims of the present application and the ‘027 Application do not overlap.

CONCLUSION

If a telephone conference with Applicant's representative would be helpful in expediting prosecution of the application, Applicant invites the Examiner to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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